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By:_____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: BAUM Application No.: 10/038,004 Filed: 1/2/2002 For: DISTRIBUTING IMAGES TO MULTIPLE RECIPIENTS	Examiner: GARG, YOGESH C Art Unit: 3625 REVISED REQUEST FOR REINSTATEMENT OF APPEAL AND APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Garg:

Per our discussion today, applicant has added in SUMMARY OF THE CLAIMED SUBJECT MATTER references to the sections of the instant specification supporting the specific limitations in the independent claims.

Appellant resubmits Request for Reinstatement of the Appeal and offers this Appeal Brief in furtherance of the Office Action mailed on August 12, 2005 in the above-referenced patent application. Appendix A, attached hereto, contains a copy of all claims pending in this case.

REAL PARTY IN INTEREST

All right, title, and interest in the subject invention and application are assigned to
Shutterfly, Inc., having offices at 2800 Bridge Parkway, Suite 101, Redwood City, CA
94065. Therefore, Shutterfly, Inc. is the real party interest.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or be
directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1-21 are present in the application. Claims 1, 14, 16, 17 and 21 were
amended in an RCE preliminary amendment in response to Comments made in the
Examiner's Answer mailed 8/26/03 for the First Appeal Brief filed on July 1, 2003.
Claims 1-21 have been rejected and are the subjects of this appeal. No other claims are
pending.

STATUS OF AMENDMENTS

A Final Office Action was mailed on 6/17/04. No amendment has been filed in
response to the Final Office Action. An After Final Response was submitted on 7/13/04.
An Advisory Action was mailed 8/10/04 noting that the Terminal Disclaimer was not
acceptable. A substitute Terminal Disclaimer and Notice of Appeal were filed on
8/31/04. A copy of all the pending claims is provided in Appendix A, attached hereto.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is related generally to distributing images, for example,
digital and/or physical copies of images, to multiple recipients.

In accordance one aspect of the invention, one way to place an order is by having
the user view previously uploaded images online, for example, with a browser and
selectively designate which images should be printed. The user also will specify one or
more recipients to whom prints should be distributed and, further, print parameters for
each of the individual recipients, for example, not only parameters such as the size,
number of copies and print finish, but potentially also custom messages to be printed on

2

the back or front of a print. Application at page 19, lines 3-10. After the recipients and respective parameters have been specified, the user's order is fulfilled by making prints of the designated images and distributing them to the specified recipients (step 406). Application at page 19, lines 15-18.

Fig. 5 shows an exemplary graphical user interface (GUI) based environment that employs iconographic aliases (graphical representations of distribution groups) and graphical input techniques to enable a user to designate intended recipients of digital images and/or prints of the digital images. In the example shown in Fig. 5, the user, Jane Smith, has accessed her most recently uploaded images by entering into the browser's Address field 520 a uniform resource locator (URL) address 521 provided to her by the photo-finisher and corresponding to a web page at which her most recent images are hosted. In response, the browser window 501 accesses the specified address and displays its contents, namely, a greeting message 522, twelve images 508-519 recently uploaded by Jane, a link 523 to an archive that includes all of Jane's uploaded images, photo albums 524-526 representing collections of related images as grouped by Jane, and a picture delivery bar 500. Application, page 20, lines 5-15.

The picture delivery bar 500 includes one or more iconographic distribution aliases 502-507, each of which represents a distribution group of one or more recipients. The recipients specified in a distribution group may or may not have overlapping members in common with other distribution groups. For example, a member of the user's Friends distribution alias 504 may include one or more recipients who also are members of that user's Basketball Team distribution alias 506 or Co-workers distribution alias 505. In general, no limitations exist on the number or identities of members in a particular distribution alias. Application, page 20, lines 16-23.

As shown above, ease of use is provided to the user who orders a plurality of cards for different recipients. The cards may or may not be customized (for example, customized border or customized cropping, among others). This capability is useful during the winter holiday season, for example, to allow users to order 50 to 100 Christmas cards online for their family members and friends, who may be residing at different locations. Running through an order process one at a time for each of the 50-100

3

Christmas cards is time consuming.   This inconvenience in prior art ordering systems

would deter many users from using the customized features for online card ordering.

Regarding claim 1, the limitations can be found in the following sections of the

instant application as cited in the parenthesis below:

A computer-implemented method of distributing cards to a plurality of recipients,
the method comprising:
receiving a single card order specifying a plurality of recipients and, for each
specified recipient, a set of one or more images directly uploaded by a user
associated with that recipient, wherein the single card order is completed in a
single transaction sequence;
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-
23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

for each of the plurality of recipients specified in the received card order, printing
at least one card having at least one user-uploaded image from the recipient's
image set; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14
line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

distributing the printed cards having the recipients' user-uploaded images to their
respective associated recipients.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

Regarding claim 14, the limitations can be found in the following sections of the

instant application as cited in the parenthesis below:

A card distribution system comprising:

a front-end computer sub-system for receiving a single card order specifying a
plurality of recipients and, for each specified recipient, a set of one or more
images associated with that recipient, such images being directly uploaded by a
user to the front-end computer sub-system, wherein the single card order is
completed in a single transaction sequence;
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-
23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

a printing sub-system for printing at least one card having at least one uploaded
image in each recipient's image set; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14
line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

a distribution sub-system for distributing the printed cards to their respective
associated recipients.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

4

Regarding claim 16, the limitations can be found in the following sections of the instant application as cited in the parenthesis below:

A computer-implemented method of ordering cards for a plurality of recipients, the method comprising:

receiving at a host system a single card order from a client system, the card order corresponding to a single transaction sequence and specifying a plurality of recipients and, associated with each specified recipient, a set of one or more images directly uploaded by a user, wherein the single card order is completed in a single transaction sequence.
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

Specifically, page 5 lines 19 to 21 disclose:

"the physical manifestation of the set of digital content may include a card (e.g., a greeting card, a holiday card, an announcement, a playing card, a post card, a thank you card, or an invitation)..."

Regarding claim 17, the limitations can be found in the following sections of the instant application as cited in the parenthesis below:

A computer-implemented method of creating and distributing personalized social and business print communications to one or more recipients specified by a user, comprising:

uploading image data directly from the user specifying an appearance of the print communications;
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

obtaining message data from the user specifying message content to be included in the print communications;
(FIG. 7C, FIG. 9)

obtaining address information from the user specifying names and addresses of the one or more recipients in a single transaction sequence;
(FIG. 6)

producing the print communications incorporating the uploaded image data and the message data; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14 line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

distributing the print communications to the one or more recipients in accordance with instructions provided by the user.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

5

Regarding claim 21, the limitations can be found in the following sections of the instant application as cited in the parenthesis below:

A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a single card order from an orderer, such order specifying a plurality of recipients where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more images directly uploaded by the orderer associated with that recipient, wherein the single card order is completed in a single transaction sequence;
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14 line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

ISSUES

I.   Whether claims 1-10, and 13-21 are anticipated by Lockhart (Application Serial No. 2002/0103697) under 35 U.S.C. § 102(e).

II.   Whether claims 11-12 are unpatentable over Lockhart and Harman. (USPN 5,960,411) under 35 U.S.C. § 103(a).

ARGUMENT

I.   CLAIMS 1-10, AND 13-21 ARE NOT ANTICIPATED BY LOCKHART

Claims 1-10, and 13-21 were rejected as anticipated by Lockhart (Application Serial No. 2002/0103697) under 35 U.S.C. § 102(e).

6

REJECTION OF CLAIMS 1-10, 13

Claim 1 of the instant application includes the following limitations. The exemplified sections in support each of the limitations are cited in the parenthesis.

A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:
receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence;
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14 line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

Specifically, page 5 lines 19 to 21 disclose:

"the physical manifestation of the set of digital content may include a card (e.g., a greeting card, a holiday card, an announcement, a playing card, a post card, a thank you card, or an invitation)..."

FIG. 3B and related specification disclose that an image order can include a plurality of suborders each to be shipped to a different recipient.

Page 4 line 9 – 12 discloses:

"the order may include a single transaction sequence such as a single charge to a financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button."

The instant specification therefore discloses system and methods that allow a user to order cards containing user-uploaded images for a plurality of recipients and the card order can completed in a single transaction sequence.

Regarding claim 1, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is

8

then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 1.

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

> [0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is

positive, the balance is decremented in accordance with the postage required for the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing. The element of "receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence" in claim 1 is missing in Lockhart. Lockhart does not show receiving a single card order specifying recipients that is completed in a single transaction sequence.

In sum, since one or more elements are missing and the elements are not arranged as required in claim 1, Applicants submit that Lockhardt cannot anticipate claim 1 as well as claims 2-9 and 13 that depend therefrom. Withdrawal of the rejection on claims 1-10 and 13 is requested.

REJECTION OF CLAIMS 14 AND 15

Claim 14 of the instant application includes the following limitations. The sections in support each of the limitations is cited in the parenthesis.

A card distribution system comprising:

a front-end computer sub-system for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient, such images being directly uploaded by a user to the front-end computer sub-system, wherein the single card order is completed in a single transaction sequence;
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

a printing sub-system for printing at least one card having at least one uploaded image in each recipient's image set; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14 line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

a distribution sub-system for distributing the printed cards to their respective associated recipients.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

Specifically, page 5 lines 19 to 21 disclose:

"the physical manifestation of the set of digital content may include a card (e.g., a greeting card, a holiday card, an announcement, a playing card, a post card, a thank you card, or an invitation)…"

FIG. 3B and related specification disclose that an image order can include a plurality of suborders each to be shipped to a different recipient.

Page 4 line 9 – 12 discloses:

"the order may include a single transaction sequence such as a single charge to a financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button."

The instant specification therefore discloses system and methods that allow a user to order cards containing user-uploaded images for a plurality of recipients and the card order can completed in a single transaction sequence.

Regarding claim 14, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

11

Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage,

12

and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 14.

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

> [0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is positive, the balance is decremented in accordance with the postage required for

13

the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing. The element of "a front-end computer sub-system for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient, such images being directly uploaded by a user to the front-end computer sub-system, wherein the single card order is completed in a single transaction sequence" in claim 14 is missing in Lockhart. Lockhart does not show receiving a single card order specifying recipients that is completed in a single transaction sequence.

In sum, since one or more elements are missing and the elements are not arranged as required in claim 14, Applicants submit that Lockhardt cannot anticipate claim 14 as well as claim 15 that depends therefrom. Withdrawal of the rejection on claims 14 and 15 is requested.

14

REJECTION OF CLAIM 16

Claim 16 of the instant application includes the following limitations. The sections in support each of the limitations is cited in the parenthesis.

A computer-implemented method of ordering cards for a plurality of recipients, the method comprising:

receiving at a host system a single card order from a client system, the card order corresponding to a single transaction sequence and specifying a plurality of recipients and, associated with each specified recipient, a set of one or more images directly uploaded by a user, wherein the single card order is completed in a single transaction sequence.
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

Specifically, page 5 lines 19 to 21 disclose:

"the physical manifestation of the set of digital content may include a card (e.g., a greeting card, a holiday card, an announcement, a playing card, a post card, a thank you card, or an invitation)..."

FIG. 3B and related specification disclose that an image order can include a plurality of suborders each to be shipped to a different recipient.

Page 4 line 9 – 12 discloses:

"the order may include a single transaction sequence such as a single charge to a financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button."

The instant specification therefore discloses system and methods that allow a user to order cards containing user-uploaded images for a plurality of recipients and the card order can completed in a single transaction sequence.

Regarding claim 16, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach

15

specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under

16

consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 16.

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

> [0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is positive, the balance is decremented in accordance with the postage required for the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which

17

the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing. The element of "receiving at a host system a single card order from a client system, the card order corresponding to a single transaction sequence and specifying a plurality of recipients and, associated with each specified recipient, a set of one or more images directly uploaded by a user, wherein the single card order is completed in a single transaction sequence" in claim 16 is missing in Lockhart. Lockhart does not show receiving a single card order specifying recipients that is completed in a single transaction sequence.

In sum, since one or more elements are missing in claim 16, Applicants submit that Lockhardt cannot anticipate claim 16. Withdrawal of the rejection on claims 16 is requested.

REJECTION OF CLAIMS 17 - 20

Claim 17 of the instant application includes the following limitations. The sections in support each of the limitations is cited in the parenthesis.

A computer-implemented method of creating and distributing personalized social and business print communications to one or more recipients specified by a user, comprising:
uploading image data directly from the user specifying an appearance of the print communications;

18

(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

obtaining message data from the user specifying message content to be included in the print communications;
(FIG. 7C, FIG. 9)

obtaining address information from the user specifying names and addresses of the one or more recipients in a single transaction sequence;
(FIG. 6)

producing the print communications incorporating the uploaded image data and the message data; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14 line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

distributing the print communications to the one or more recipients in accordance with instructions provided by the user.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

Specifically, page 5 lines 19 to 21 disclose:

"the physical manifestation of the set of digital content may include a card (e.g., a greeting card, a holiday card, an announcement, a playing card, a post card, a thank you card, or an invitation)..."

FIG. 3B and related specification disclose that an image order can include a plurality of suborders each to be shipped to a different recipient.

Page 4 line 9 – 12 discloses:

"the order may include a single transaction sequence such as a single charge to a financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button."

The instant specification therefore discloses system and methods that allow a user to order cards containing user-uploaded images for a plurality of recipients and the card order can completed in a single transaction sequence.

Regarding claim 17, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user

19

associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient' s image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

20

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 17.

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

[0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is positive, the balance is decremented in accordance with the postage required for the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user

21

may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing. The element of "obtaining address information from the user specifying names and addresses of the one or more recipients in a single transaction sequence" in claim 17 is missing in Lockhart. Lockhart does not show receiving a single card order specifying recipients that is completed in a single transaction sequence.

In sum, since one or more elements are missing and the elements are not arranged as required in claim 17, Applicants submit that Lockhardt cannot anticipate claim 17 as well as claims 18-20 that depend therefrom. Withdrawal of the rejection on claims 17-20 is requested.

REJECTION OF CLAIM 21

Claim 21 of the instant application includes the following limitations. The exemplified sections in support each of the limitations are cited in the parenthesis.

A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a single card order from an orderer, such order specifying a plurality of recipients where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more images directly

22

uploaded by the orderer associated with that recipient, wherein the single card order is completed in a single transaction sequence;
(page 3, line 29 to page 4 line 4; page 4 line 19 to Page 5 line 5; page 5, lines 6-23; FIG. 3A; FIG 3B; FIGS. 4-7; Page 13, line 9 – page 19 line 14)

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and
(line 29 to page 4 line 4; page 7 line 16 - page 12 line 14; FIG. 4; FIG. 8; page 14 line 15 – page 20 line 4; page 26 line 29 – page 28 line 14)

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.
(page 4 lines 13-18; page 5 line 24 to page 6 line 28; FIG. 6; FIG. 9)

Specifically, page 5 lines 19 to 21 disclose:

"the physical manifestation of the set of digital content may include a card (e.g., a greeting card, a holiday card, an announcement, a playing card, a post card, a thank you card, or an invitation)…"

FIG. 3B and related specification disclose that an image order can include a plurality of suborders each to be shipped to a different recipient.

Page 4 line 9 – 12 discloses:

"the order may include a single transaction sequence such as a single charge to a financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button."

The instant specification therefore discloses system and methods that allow a user to order cards containing user-uploaded images for a plurality of recipients and the card order can completed in a single transaction sequence.

Regarding claim 21, the Office Action asserted that Lockhardt shows a computer-implemented method of distributing cards to a plurality of recipients as follows:

Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021=0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see

23

paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 "....and from which the user may select one or more desired addresses" (step 220...)) and paragraph 0088, "...For example, a single card design may be used for a variety of recipients...]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Lockhardt fails to show a number of claimed elements and thus cannot anticipate claim 21.

24

Turning now to the rejection, paragraph 86 teaches that the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). While paragraph 86 shows an address book, the paragraph is simply silent on the claimed single card order specifying a plurality of recipients.

Similarly, paragraph 88 states that "a single card design may be used for a variety of recipients, wherein the first name of the recipient is imported from a merge data file (residing, for example, on the user's system, the mail service computer 110, or any other convenient location) and incorporated into the final mail item's text note." Paragraph 88 simply indicates that the user can share a single design with plurality of recipients using mail-merge. However, this does not show the claimed single card order specifying a plurality of recipients.

Additionally, nowhere in Paragraph 88 does it show a "card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

This understanding is further buttressed by paragraph 95 which notes that, for each recipient, the user's balance is accessed by the system. This is done *in seriatim* as follows:

> [0095] In step 206, after the recipient address for the mail item is selected, the user's account balance is accessed by the system. Such data might reside at mail service computer 110 or any convenient server. If the account balance is positive, the balance is decremented in accordance with the postage required for the mail item being sent (step 226). If the account balance is zero, or less than the required postage, then the user is provided the opportunity to purchase postcards or other mail items on-line. Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, Mastercard, etc.).

25

Figure 2 in Lockhardt clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address (step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.

In sum, the Office Action is reading more into the disclosure than what is taught by Lockhardt which suggests is mail merge can be done. Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing. The element of "receiving a single card order from an orderer, such order specifying a plurality of recipients where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more images directly uploaded by the orderer associated with that recipient, wherein the single card order is completed in a single transaction sequence" in claim 21 is missing in Lockhart. Lockhart does not show receiving a single card order specifying recipients that is completed in a single transaction sequence.

In sum, since one or more elements are missing in claim 21, Applicants submit that Lockhardt cannot anticipate claim 21. Withdrawal of the rejection on claims 21 is requested.

II.   CLAIMS 11-12 ARE UNPATENTABLE UNDER SECTION 103(A) OVER LOCKHART AND HARTMAN.

Claims 11 and 12 include the following limitations

11.   The method of claim 1, wherein the card order comprises a single transaction sequence terminated by an order icon.

12.   The method of claim 11, wherein the single transaction sequence is terminated by a click of a "card order" button.

In addition to the disclosure in support to claim 1, the base claim for claims 10 and 11, Page 4 line 9 – 12 of the instant application discloses:

26

"the order may include a single transaction sequence such as a single charge to a financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button."

Page 29 lines 17 – 20 disclose:

"...the user had a standing account with the photo-finisher (for example, specifying default information for print size and finish, number of copies, recipients, billing information, etc.), a single click by the user on the icon could cause the print order to be fulfilled automatically and without further user input or involvement."

The Office Action asserted that Claims 11-12 were rejected as unpatentable over Lockhart and Harman under 35 U.S.C. § 103(a). Hartman relates to a method and system for placing an order to purchase an item via the Internet. The order is placed by a purchaser at a client system and received by a server system. The server system receives purchaser information including identification of the purchaser, payment information, and shipment information from the client system. The server system then assigns a client identifier to the client system and associates the assigned client identifier with the received purchaser information. The server system sends to the client system the assigned client identifier and an HTML document identifying the item and including an order button. The client system receives and stores the assigned client identifier and receives and displays the HTML document. In response to the selection of the order button, the client system sends to the server system a request to purchase the identified item. The server system receives the request and combines the purchaser information associated with the client identifier of the client system to generate an order to purchase the item in accordance with the billing and shipment information whereby the purchaser effects the ordering of the product by selection of the order button.

Applicants respectfully traverse the assertion that Hartman shows the claimed receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. At best, Hartman shows clicking a mouse button to order the identified item. This is not the same as <u>receiving a single card order specifying a plurality of recipients</u> and, for each

27

specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. Hence, Hartman fails to show the claimed element.

Additionally, the combination of Lockhart and Hartman is improper because Lockhart teaches away from the claimed receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence, as discussed above. Even though Hartman shows a single action such as clicking a mouse button that a purchaser is to perform to order the identified item, there is no suggestion in Lockhart to form system that receives "a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence." There is no suggestion to combine, and the rejection is simply using hindsight taught by the instant invention to combine the references in the specific manner of claim 1.

Since at least two elements are missing in the references, the independent claims and those dependent therefrom are patentable over Lockhart and Hartman. Hence, the cited disclosures cannot render dependent claims 11-12 obvious.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Shiota reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's

28

disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

First, Applicant notes that the references fail to teach or suggest all the claim limitations of the independent claims. In particular, independent claim 1 recites receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence; for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients. The receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence is not reasonably taught or suggested in the cited art reference.

Secondly, Applicant notes that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Lockhardt reference so as to produce the claimed invention. Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in the references, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of the independent claims. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

29

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the references, or knowledge of those skilled in the art, for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence, *prima facie* obviousness of the independent claims and those dependent therefrom has not been established. As such, it is respectfully requested that the § 103(a) rejections be withdrawn and the claims be allowed.

30

CONCLUSION

Appellant believes that the above discussion is fully responsive to all grounds of rejection set for the in the Final Office Action.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,
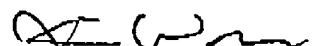
Xin Wen, Reg. 53,758
650-610-3522

31

CLAIMS APPENDIX

1.   A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence;

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.

2.   The method of claim 1, wherein the card is one or more of a greeting card, a post card, and a playing card.

3.   The method of claim 1, wherein the images in a first recipient's image set differ from the images in a second recipient's image set.

4.   The method of claim 1, wherein print parameters of a first recipient's cards differ from printing parameters of a second recipient's cards and wherein the print parameters include one or more of print size, number of copies, print finish, and/or a textual message for the printed cards.

5.   The method of claim 1, wherein the images are uploaded by a user from a digital camera.

6.   The method of claim 1, wherein the images are uploaded by a user to a printing service.

32

7.   The method of claim 1, wherein receiving, printing and distributing is dispersed among two or more different entities.

8.   The method of claim 1 wherein the steps of receiving, printing and distributing is performed by a single entity.

9.   The method of claim 1, wherein receiving a card order is performed by an enterprise providing a web front-end.

10.   The method of claim 1, further comprising, prior to printing, dividing the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient.

11.   The method of claim 1, wherein the card order comprises a single transaction sequence terminated by an order icon.

12.   The method of claim 11, wherein the single transaction sequence is terminated by a click of a "card order" button.

13.   The method of claim 1, wherein the card order further comprises charging to one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon.

14.   A card distribution system comprising:

        a front-end computer sub-system for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient, such images being directly uploaded by a user to the front-end computer sub-system, wherein the single card order is completed in a single transaction sequence;

        a printing sub-system for printing at least one card having at least one uploaded image in each recipient's image set; and

33

a distribution sub-system for distributing the printed cards to their respective associated recipients.

15.   The card distribution system of claim 14, wherein the cards are one or more of a greeting card, a post card, and a playing card.

16.   A computer-implemented method of ordering cards for a plurality of recipients, the method comprising:

receiving at a host system a single card order from a client system, the card order corresponding to a single transaction sequence and specifying a plurality of recipients and, associated with each specified recipient, a set of one or more images directly uploaded by a user, wherein the single card order is completed in a single transaction sequence.

17.   A computer-implemented method of creating and distributing personalized social and business print communications to one or more recipients specified by a user, comprising:

uploading image data directly from the user specifying an appearance of the print communications;

obtaining message data from the user specifying message content to be included in the print communications;

obtaining address information from the user specifying names and addresses of the one or more recipients in a single transaction sequence;

producing the print communications incorporating the uploaded image data and the message data; and

distributing the print communications to the one or more recipients in accordance with instructions provided by the user.

18.   The method of claim 17, wherein the images are uploaded by a user from a digital camera.

34

19.   The method of claim 17, wherein the images are uploaded by a user to a printing service.

20.   The method of claim 17, wherein the images are uploaded by a user from a data storage device.

21.   A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a single card order from an orderer, such order specifying a plurality of recipients where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more images directly uploaded by the orderer associated with that recipient, wherein the single card order is completed in a single transaction sequence;

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.

35

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE

36